

09/698,379

MS150499.1

REMARKS

Claims 1-40 are currently pending in the subject application and are presently under consideration. Claims 24 and 34 have been amended herein with novel aspects already recited in pending claims, and thus, do not raise new issues requiring additional search or effort on behalf of the Examiner. Claims 1-23, 25-33, 35 and 40 have been amended to further clarify various novel aspects of the subject invention. A listing of all claims is at pages 2-9. Favorable consideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-40 Under 35 U.S.C. §102(b)

Claims 1-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by Robertson (US 6,609,106). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Robertson does not teach or suggest each and every element of the subject claims.

A single prior art reference anticipates a patent claim *only if* it expressly or inherently *describes each and every* limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002). "A claim is anticipated *only if each and every* element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical* invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)

The subject invention generally relates system and methods that generate electronic gift and/or shopping lists that can be utilized to purchase items over the Internet. Independent claims 1, 26 and 35 recite similar limitations regarding *an item list database that stores references to items that reside in another database(s) and an interface component that utilizes the item references to extract item-related data from the other database(s) to create an item list in response to a request for the list*. Robertson does not teach or suggest such novel aspects. Rather, Robertson simply discloses viewing a registrant's item list *via* selecting the registrant at a Gift Registry site and is silent regarding *an interface component that utilizes item references*

09/698,379

MS150499.1

stored within an item list database to extract data and create an item list based on the extracted data, as recited in the subject claims.

More particularly, Robertson discloses that a registrant's item list at a gift registry site can be accessed by logging-on to the site and selecting the registrant. As disclosed, a user can log on to the Gift Registry site 70 and obtain the registrant's list of items by querying for the registrant, wherein a Gift Registrant Wish List Page is presented to the user that provides the items on the registrant's item list. (See col. 18, ll. 34-56). However, Robertson does not teach or suggest *retrieving and utilizing references to items to extract data from a database wherein the data is employed to generate an item list that is returned to a requester*, as recited in the subject claims. Moreover, Robertson does not mention an *item list database* or *storing item references* in such database. Robertson merely discloses registering items with a Gift Registry site 70 via selecting items from a product page on a service provider's web site and requesting registry of such items. As disclosed in Robertson, a registrant registers an item by adding the item to a local list and transferring the list to a Gift Registrar 74 where it is stored in a Local "Wish" List Database 64. (See col. 19, ll. 35-50; col. 10, ll. 5-9 and ll. 17-20). However, Robertson does not contemplate *storing references to the items in an item list database*, as recited in the subject claims.

Independent claim 12 recites *an interface component that degrades joined items as items are removed from a database(s)*. As disclosed in the subject application, when an item in a user's item list is removed from a database(s), the data can be degraded to provide a user with an alternate item from the database(s) and/or another database(s) such as a best available item. Such degrading can provide a user with a link to a merchant's web site or to other items. (See application, p. 7, ll. 12-24). Robertson does not teach or suggest *degrading items on a list when the items are removed from storage within a database*, as recited in the subject claim. Robertson simply discloses that a registrant can access a "Wish" list Maintenance Page at the Gift Registry site 70 to add, modify or delete an item from the user's item list (See col. 22, ll. 30-32 and col. 14, ll. 23-52) and that a shopper can purchase an item from a different provider or an item not on the list (See col. 23, ll. 27-41); however, Robertson is silent regarding *degrading an item in response to the item becoming no longer available*, as recited in the subject claim.

Independent claim 14 recites *at least one database with structured and unstructured item information that is utilized to generate an item list*. As disclosed in the subject application,

09/698,379

MS150499.1

structured information generally refers to information related to items residing in a database(s) and unstructured information generally refers to user-added information that does *not* reside or conform to any item in the database(s). (See application, pp. 7-8, ll. 25-6). Robertson does not mention utilizing *structured and unstructured information*, let alone generating *an item list with structured and unstructured item information*, as recited in the subject claim. As noted above, Robertson merely discloses creating and registering an item list by selecting items from a service provider's on-line product page and requesting that the items be registered.

Independent claim 20 recites *a system that links an infrastructure of an item list to a remote site such that the item list appears to reside on the remote site*. As disclosed in the subject application, a remote merchant site can be linked to a shopping portal with a database that stores items from a plurality of merchants. When a user at the remote merchant site requests to view items, the items can be filtered such that only items associated with the remote site are returned to the user. Thus, only products from the remote merchant can be added to the item list through the merchant's site; and thus, it appears to the user that the item list resides at the remote merchant's site. (See application, p.14, ll. 10-26). Robertson does not teach or suggest *linking an item list infrastructure to a remote site* such that it appears to a user that the item list resides at the remote site when it does not. Rather, Robertson discloses accessing a service provider's product page (not a filtered list of many merchants) from the service provider's site and selecting products from that product page in order to add items to the item list. (See col. 19, ll. 35-42). Thus, Robertson discloses items reside with the service provider and does not contemplate retrieving an item list from a shopping portal *via a link to an item list infrastructure*, as recited in the subject claim.

In view of the foregoing, it is readily apparent that Robertson does not teach or suggest *each and every element as set forth in* independent claims 1, 12, 14, 20, 26, and 35. In addition, independent claims 24 and 34 have been amended herein, and it is believed that the amendments place these claims in condition of allowance. Accordingly, the rejection of independent claims 1, 12, 14, 20, 24, 26, 34 and 35 (and dependent claims 2-11, 13, 15-19, 21-23, 25, 27-33, and 36-40) should be withdrawn.

09/698,379

MS150499.1

CONCLUSION

The present application is believed to be in condition for allowance, in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP ✓



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731